

Remarks/Arguments

Upon entry of the amendments made herein, claims 1, 4, 29-36, 42, 43, 49-62, 66-82, 84 and 85 are pending in the application. By this amendment, Applicants have amended claims 1, 29, 60, 62, 66-69, 80, 81, 84 and 85. Claims 2, 3, 5-28, 37-41, 44-48, 63-65, 83, 86 and 87 were previously canceled.

Claims 1, 29, 60, 62, 66-69, 80 and 81 have been amended to correct inadvertent typographical errors and/or to further define the invention. Claims 84 and 85 have been amended to further define the invention. Support for the amendments to claims 84 and 85 can be found in the specification and claims as originally filed, *e.g.*, from page 79, line 22 through page 80, line 7. Accordingly, no new matter has been added.

Formal Matters

Applicants note that their Response to the Final Office Action, filed on November 2, 2009, included an Amendment to the Specification. Applicants request that the Examiner acknowledge this Amendment has been entered into the record.

Applicants further note that, following the issuance of the Advisory Action, the Examiner contacted Applicants' attorney to request an interview to discuss the status of the instant case. At the Examiner's request, a total of four interviews were attempted. An initial interview was scheduled for December 30, 2009. Following an unsuccessful attempt to contact the Examiner via telephone at the scheduled time, the Examiner returned our call and requested that the interview be rescheduled. Three additional interviews were scheduled for January 11, 2010, January 28, 2010 and February 5, 2010. Each time, the Examiner was not available to participate in the scheduled call.

As a result, Applicants lost a total of 62 days (from the mailing of the Advisory Action on December 9, 2009 to the instantly filed Request for Continued Examination on February 9, 2010) due to the Examiner's unavailability. As such, Applicants submit the duration from the mailing of the Advisory Action through the filing of the instant Request for Continued Examination is not Applicant delay.

Double Patenting

Applicants note that a summary of these rejections was transmitted to the Examiner, in accordance with the Examiner's request, via facsimile on January 28, 2010.

Claims 1, 4, 29-36, 42, 43, 49-62, 66-82, 84 and 85 have been provisionally rejected on the ground of 35 U.S.C. §101 as claiming the same invention as that of claim 165 of U.S. Application No. 10/835,635.

As stated in Applicants' previous Response filed on June 4, 2009, Applicants believe this rejection is directed to U.S. Application No. 10/853,635 (now U.S. Patent No. 7,595,309), since U.S. Application No. 10/835,635 (now U.S. Patent No. 7,247,176) is drawn to an "apparatus and method for removing fine particles during fabrication of a portable camera module." Further, U.S. Application No. 10/835,635 is not assigned to Paratek Pharmaceuticals, Inc. and is not currently pending (*i.e.*, application has issued as US Patent No. 7,247,176).

Claim 165 of U.S. Application No. 10/853,635 (now U.S. Patent No. 7,595,309) is drawn to a tetracycline compound. However, the currently pending claims are drawn to methods and pharmaceutical compositions comprising the use of several tetracycline compounds. Thus, claim 165 of U.S. Application No. 10/853,635 is drawn to different statutory subject matter than that of the currently pending claims. Furthermore, claim 165 of U.S. Application No. 10/853,635 describes a tetracycline compound substituted with a phenyl ring at the 7-position. The current claims do not include 7-phenyl substituted tetracycline compounds. Thus, claims 1, 4, 29-36, 42, 43, 49-62, 66-82, 84 and 85 do not claim the same invention as that of claim 165 of U.S. Application No. 10/853,635. As such, Applicants request withdrawal of this provisional rejection.

Claims 1, 3, 4, 29-36, 42, 43, 49-62, 66-82, 84 and 85 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 165 and 184 of U.S. Application No. 10/853,635 (now U.S. Patent No. 7,595,309); claims 109 and 115 of copending U.S. Application No. 10/996,119; and claims 1-5 of copending U.S. Application No. 12/351,409.

As stated in Applicants' previous Responses filed on June 4, 2009 and November 2, 2009, Applicants note that U.S. Application No. 12/351,409 is not publicly accessible on the USPTO website. Furthermore, this application is not accessible on Private PAIR. In fact, U.S. Application No. 12/351,409 is not a copending application which is assigned to the instant assignee, Paratek Pharmaceuticals, Inc. As such, Applicants request withdrawal of this provisional rejection.

With regard to U.S. Application No. 10/996,119, Applicants traverse the rejection. As currently amended, claim 109 of U.S. Application No. 10/996,119 is drawn to pharmaceutical compositions comprising a tetracycline compound useful for the treatment of multiple sclerosis

or arthritis. (Applicants note that claim 115 of U.S. Application No. 10/996,119 is canceled and, thus, this rejection is moot with respect to this claim.) The currently pending claims are drawn to methods for the treatment of malaria and related methods. Applicants submit that one of skill in the art would not reasonably expect to treat malaria with a composition designed for the treatment of multiple sclerosis or arthritis as these diseases are entirely unrelated. Thus, the subject matter described in the current claims is not obvious in view of claim 109 of U.S. Application No. 10/996,119. As such, Applicants request withdrawal of this provisional rejection.

With regard to U.S. Application No. 10/853,635 (now U.S. Patent No. 7,595,309), Applicants previously submitted a terminal disclaimer, filed on November 2, 2009.

Claims 1, 4, 29-36, 42, 43, 49-62, 66-82, 84 and 85 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of copending U.S. Application No. 11/490,867.

Applicants traverse this provisional double patenting rejection. M.P.E.P. § 804 section I, subsection B1 provides as follows:

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.

The instant application was filed on October 24, 2003. The cited co-pending Application No. 11/490,867 was filed after October 24, 2003. Thus, the instant application is the earlier-filed application with respect to these applications. Accordingly, this provisional double patenting rejection should be withdrawn upon the favorable resolution of all other outstanding rejections.

Unspecified claims have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over copending U.S. Application Nos. 12/351,409; 10/921,580; 10/943,571; 10/996,119; 11/039,230; 11/348,608 and 11/490,867.

As described above, U.S. Application No. 12/351,409 is not a copending application assigned to the instant assignee, Paratek Pharmaceuticals, Inc. As such, Applicants request withdrawal of this provisional rejection.

With respect to U.S. Application No. 10/921,580, this application is abandoned. As such, Applicants request withdrawal of this provisional rejection.

With respect to U.S. Application Nos. 10/996,119 and 11/490,867, the arguments made above with respect to these applications are incorporated herein. As such, Applicants request withdrawal of these provisional rejections.

With respect to U.S. Application Nos. 11/039,230 and 11/348,608, Applicants recognize that the Examiner has noted Applicants' traversal of these provisional double patenting rejections in view of M.P.E.P. at § 804 section I, subsection B1 (*see* Final Office Action at p. 8). Accordingly, Applicants respectfully request withdrawal of these provisional double patenting rejections upon indication of allowable subject matter in the instant application.

With respect to U.S. Application No. 10/943,571, Applicants traverse the rejection. As currently amended, the claims of U.S. Application No. 10/943,571 are drawn to pharmaceutical compositions comprising a tetracycline compound useful for the treatment of disease associated with specific fungi. The currently pending claims are drawn to methods for the treatment of malaria and related methods. Applicants submit that it would not be obvious to treat malaria with a composition designed for the treatment of a disease associated with the specific fungi claimed in U.S. Application No. 10/943,571 as these diseases are entirely unrelated. Thus, one of skill in the art would not reasonably expect that the compositions described in U.S. Application No. 10/943,571 would successfully treat malaria. As such, Applicants request withdrawal of this provisional rejection.

Conclusion

Applicants submit that this paper is fully responsive and that the application is in condition for allowance. Should any questions arise concerning the application, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



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